

REMARKS

Applicant has again updated the reference to related applications to reflect the issuance of the parent application and has amended claim 13 to supply a missing period. Applicant has also amended the claims and added claims so as to claim separately the processes and compositions of this invention as they relate to episulfide monomers, diethylene glycol bisallylcarbonate and thiourethane monomers. Since the amendments are either directed to minor formalities or simply divide the claimed subject matter into groups whose combined extent is the same as the scope of the claims prior to this amendment, these amendments do not narrow the scope of the pending claims. Upon entry of the amendments above, claims 1-4 and 12-22 will be pending in this application.

Applicant submits a terminal disclaimer, attached hereto, to overcome the double patenting rejection. The Office Action contains a typographical error in referring to U.S. Patent No. 6,442,119, which is assigned to a company called Taiyo Yuden and relates to methods for recording optical information. The attached terminal disclaimer correctly refers to the patent as U.S. Patent No. 6,441,119. Applicant requests withdrawal of the double patenting rejection.

Claims 1-4, 12 and 13 stand rejected as anticipated by Amagai '061. The Examiner's reasoning in support of the rejection reads as follows:

Amagai discloses optical materials made from episulfide monomers (see col. 2, line 20), and he discloses adding 2-(2-hydroxy-4'-n-octoxyphenyl)-benzotriazole as a UV absorber (col. 7, line 49). It's been held generally not judicious [sic] to choose a species from a single list (In re Wiggins [sic, Wiggins], 179 USPQ 421). All the examples of Amagai show the same yellowness index values as those specified in the claims. The amount of benzotriazole added would determine the amount of UV light absorbed or transmitted. Amagai teaches adding 0.01-0.3 wt% (col. 11, line 42), which overlaps the amount taught by the applicant (0.01-5 wt% on page 5, par. 2 under "Detailed Description").

This rejection and its supporting reasoning are respectfully traversed.

Since claims 1-4, 12 and 13 (and new claims 18-22) do not cover optical materials made from episulfide monomers, Amagai neither identically discloses nor suggests their subject matter, so claims 1-4, 12, 13 and 18-22 are patentable over Amagai and should be allowed.

Before discussing the technical merits of this rejection as to claims 14-17, applicant wishes to point out, with all respect to the Examiner, that a key part of the statement of rejection, the sentence reading “It’s been held generally not judicious [sic] to choose a species from a single list (In re Wiggins [sic, Wiggins], 179 USPQ 421),” is incomprehensible. What does the Examiner mean by this? From what applicant’s attorney can glean from this sentence, the Examiner is saying that choosing a species from a single list is not a good idea, which would imply that Amagai is *not* a good reference against applicant’s claims. This impression is strengthened by *Wiggins* itself.

The court in *In re Wiggins*, 488 F.2d 538, 179 USPQ 421 (CCPA 1973), reversed an anticipation rejection of claims directed to an anti-Parkinson’s compound made by a process involving the condensation of a urea or thiourea with a disubstituted malonic ester. The rejection relied on a reference that allegedly listed a compound falling within the scope of the rejected claims. In reversing the rejection, the court rejected the PTO’s argument that the naming of a compound in a reference presumptively constitutes a description of that compound as required to support a rejection under 35 USC 102. *Id.* at 543, 179 USPQ at 424-25. Applicant is at a loss to understand how *Wiggins* supports the rejection in this application.

Amagai does not anticipate claims 14-17 for the reason that it does not put persons of ordinary skill in the art in possession of the entirety of the claimed subject matter, which includes not only the resin and UV absorbent but also the yellowness index and UV transmittance properties claimed. The UV absorber claimed in claims 14-17 is one of dozens listed in Amagai

at col. 7, lines 25-59. There is nothing in Amagai to point the person of ordinary skill in the art in the direction of 2-(2-hydroxy-4-octyloxyphenyl)-benzotriazole to arrive at the claimed subject matter. To paraphrase the Examiner's comment regarding *In re Wiggins*, there is nothing in Amagai to make it "judicious" to select the single claimed species from Amagai's list. The examples of Amagai all use different UV absorbents than the claimed UV absorbent, so the YI and UV transmittance results reported in Amagai do not teach the claimed subject matter, since there is no evidence in Amagai that a person of ordinary skill in the art would expect the claimed results from using UV absorbents other than those tested by Amagai or that the claimed results inherently flow from using the claimed UV absorbent in conjunction with what Amagai discloses. Thus, the anticipation rejection of claims 14-17 cannot be sustained on Amagai.

In order to demonstrate the factual validity of this argument, the applicant, Mr. Kosaka, tested the UV absorbents tested by Amagai to determine whether using those exemplified UV absorbents with episulfide monomers would produce the claimed YI and UV transmittance properties. Mr. Kosaka's attached declaration demonstrates conclusively that using Amagai's exemplified UV absorbents does not produce the claimed YI and UV transmittance properties. This evidence eliminates any argument that Amagai inherently anticipates the claimed invention.

In light of the foregoing, early action allowing claims 1-4 and 12-22 is solicited.

Attached hereto is a marked-up version of the changes made to the specification and claims by this amendment, captioned "Version with markings to show changes made."

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge

the cost of such petitions and/or other fees due in connection with the filing of this document to

Deposit Account No. 03-1952, referencing docket number 279222000501.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Specification:

Rewrite the Reference to Related Applications on page 1 as follows:

This application is a continuation of Serial No. 09/666,415, filed September 20, 2000, now U.S. Patent No. 6,441,119. This application claims priority from Japanese Application No. 11-265297, filed September 20, 1999, the entire disclosure of which is hereby incorporated herein by reference. This application discloses subject matter related to subject matter disclosed in co-pending U.S. patent application: Serial No. 09/666,414, filed September 20, 2000, which claims priority from Japanese Application No. 11-265321, filed September 20, 1999, the entire disclosures of which are hereby incorporated herein by reference. The disclosures of patents, applications and publications referred in this application are also incorporated herein by reference.

In the Claims:

1. (Twice Amended) A method for producing an optical lens comprising,
adding 2-(2-hydroxy-4-octyloxyphenyl)-benzotriazole to a monomer selected from the group consisting of a diethylene glycol bisallylcarbonate monomer, a thiourethane monomer and a episulfide monomer to form a mixture, and
polymerizing the monomer in the mixture to form the optical lens,
wherein the optical lens has a yellowness index (YI) between about 0.7 and 1.6 and a 380 nm UV transmittance of at most 30 % measured when the monomer is a diethylene glycol bisallylcarbonate monomer and a thickness of the optical lens is about 2.2 mm;

~~wherein the optical lens has a yellowness index (YI) between about 0.7 and 1.6 and a 380 nm UV transmittance of at most 30 % when the monomer is a thiourethane monomer and a thickness of the optical lens is about 2.2 mm and~~

~~wherein the optical lens has a yellowness index (YI) between about 0.7 and 1.8 and a 400 nm UV transmittance of at most 30 % when the monomer is a episulfide monomer and a thickness of the optical lens is about 1.8 mm.~~

3. (Twice Amended) An optical lens comprising 2-(2-hydroxy-4-octyloxyphenyl)-benzotriazole and a polymer formed by polymerizing a monomer selected from the group consisting of a diethylene glycol bisallylcarbonate monomer, a thiourethane monomer and a episulfide monomer.

12. (Twice Amended) Spectacles comprising the optical lens according to claim 3, 4 or 13.

13. (Twice Amended) The optical lens according to claim 3,
wherein the optical lens has a yellowness index (YI) between about 0.7 and 1.6 and a 380 nm UV transmittance of at most 30 % measured when the monomer is a diethylene glycol bisallylcarbonate monomer and a thickness of the optical lens is about 2.2 mm;

~~wherein the optical lens has a yellowness index (YI) between about 0.7 and 1.6 and a 380 nm UV transmittance of at most 30 % when the monomer is a thiourethane monomer and a thickness of the optical lens is about 2.2 mm and~~

~~wherein the optical lens has a yellowness index (YI) between about 0.7 and 1.8 and a 400 nm UV transmittance of at most 30 % when the monomer is a episulfide monomer and a thickness of the optical lens is about 1.8 mm.~~